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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,673	12/30/2003	Hiroyuki Egami	122.1575	2908
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER WALSH, DANIEL I	
			ART UNIT 2887	PAPER NUMBER
			MAIL DATE 10/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,673

Applicant(s)

EGAMI ET AL.

Examiner

DANIEL WALSH

Art Unit

2887

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of the amendment received on 6-16-08.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite that the sensor detects the bills being taken out (last line of claim 1, for example). This does not appear to be disclosed by the Specification, which only teaches that sensor detects a hand/motion. The specification does not teach the ability of the sensors to detect bill removal as opposed to mere movement, which does not necessarily correspond to bill removal.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. It is unclear how the sensor can detect bills being taken out. For purposes of Examination, the Examiner will interpret this as detection motion, which can include bill removal.

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 4-8, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oda et al. (US 6,731,778) in view of Fujioka (US 7,014,105).

Re claim 3, Oda et al. teaches an ATM with a bill receptacle and a security camera that captures an image when one accesses the receptacle (FIG. 2). As the hand sensor is inside the receptacle, and trips the camera to capture the image, it is understood that the image would therefore include inside the receptacle, namely the hand location, which is inside the receptacle.

The ATM as known in the art can be used for depositing and withdrawals. Oda et al. teaches a bill receptacle 20, but is silent to it having a shutter. However, the Examiner notes that shutters for such bill receptacles are known in the art for additional security/protection, and therefore is an obvious expedient for such predictable results. Oda et al. teaches a security camera 17 that captures an interior of the bill receptacle when the hand is detected (shutter would therefore be open). Oda et al. is silent to the camera being positioned in the shutter. However, Oda et al. teaches that the placement of the camera 17 is so that one camera with one frame can capture an image of both the face and hands of the users to reduce complexity/cost, while also reducing image data (col 7, lines 1+ and FIG. 34-35), as opposed to having a separate camera at each body part location that is desired to be captured, as previously done. Therefore, the Examiner notes that it would have been obvious to one of ordinary skill in the art, in light of the teachings of Oda et al. to have a separate camera in the bill receptacle to capture a picture of the hand of a user, as Oda et al. teaches that was previously done, to provide a known solution to a known problem with expected results. Though silent to the camera being in the bill receptacle, the Examiner notes that it would have been obvious to one of ordinary skill in the art, to have a camera in the bill receptacle if one desires a separate image of the hand of the user, in order to capture a detected hand. Having the camera within the receptacle is an obvious expedient to be closer to the subject of the image and to potentially be discrete. Having separate image capture at separate locations provides the benefits of separate images which can include more accurate/detailed/focused images, and a wider angle range for the specific field of view. Further, having a plurality of camera sites is harder for a customer to block capture of. Separate cameras also provides the benefit of protection of 1 camera going offline, other images can still be captured from the other

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devices. The mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Therefore, merely replacing one camera to capture two body locations, with one is well within the skill in the art. Placement within the receptacle is an obvious expedient to have the expected results of being closer to the subject of image capture, having a wider angle range to capture because only 1 subject is to be captured, while also being harder to block and possibly more discrete an installation. *Oda et al.* teaches a single sensor 46 and not a plurality. However, the Examiner notes that the mere duplication of the essential working parts of a device involves only routine skill in the art. (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8). Plural sensors might provide more accurate coverage, for example.

Nonetheless, *Fujioka* teaches a shutter 6.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of *Oda et al.* with those of *Fujioka* for security/protection/safety.

Re claim 4 and 9, the Examiner notes that *Oda et al.* teaches that the CPU starts monitoring a time when the operation is completed (such as when the card/coin/banknote/currency/etc. is no longer detected by a sensor, takes images, and if the images show that the user is not present, the transaction is cancelled and takes in the card, currency, bankbook, etc. (col 30, lines 28+). This is done for security purposes, for if someone forgets to remove currency/their card, etc., the machine takes pictures and cancels the transaction and takes back into it, the card/cash/money, etc. Though silent to doing this when the shutter is opened and the money is not taken out, the Examiner notes that a shutter has been discussed as

an obvious expedient to provide security/protection. Therefore, the Examiner believes, that in light of the teachings above where the card, bankbook, bank note, coins, etc. are taken back into the machine when a user is not detected after a predetermined time, it would have been obvious to do so when the shutter is opened and the money is not taken out, in order to provide security in instances when a user forgets to remove the currency. As this capturing occurs to protect the user when the money is not taken for example, it would have been obvious that such instances include when the sensors have not been triggered, as such is indicative of the money not being taken.

Re claims 5-8 and 10-15, Oda et al. teaches separate security cameras 217 and 218, and as discussed above, a separate camera in the receptacle as well. The Examiner notes that the cameras 217 and 218 capture non-overlapping ranges/independent images, as one captures facial images, the other captures hand images. Further, as discussed above, insertion of a camera into the receptacle to capture hand entry in there would also be interpreted as an independent image/non-overlapping.

Re claim 16, the limitation have been discussed above.

Re claim 17, Oda et al. teaches that if a threshold of time is exceeded, that the bills are taken back into the machine and images are captured. Oda et al. only teaches one threshold for activation of both steps of taking back bills and image capture. However, as Oda et al. teaches that if the users have forgotten to take out the banknotes, an alarm sounds three times, then the machine takes back the card/money, cancelling the transaction, and then captures image data (FIG. 33), Oda et al. teaches the same order/sequence of steps as claimed. The Examiner notes that adding an additional time threshold is mere duplication of a working element, known in the

art, such duplication being recognized as within the ordinary skill in the art. Adding an additional threshold is merely applying a known technique to a known device/system/method to yield predictable results, not unexpected results. As such, it is not seen as a product of innovation, but merely a product of ordinary skill in the art. Supplying an additional time threshold to accomplish that which has been previously accomplished with a single disclosed time threshold is therefore seen as an obvious expedient/matter of design choice.

Re claim 18, the limitations have been discussed above.

Response to Arguments

5. Applicant's arguments filed have been fully considered but they are not persuasive. Re the Applicants arguments that the prior art does not teach capturing an image of the interior of the bill receptacle and determining if bills remain, this has been discussed above.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (See PTO-892).

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Paik can be reached on (571) 272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel I Walsh/
Examiner
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